REMARKS

This Amendment is submitted in reply to the non-final Office Action mailed on September 16, 2009. A Petition for a one month extension of time is submitted herewith. The Director is authorized to charge $120.00 for the Petition for a one month extension of time and any additional fees that may be required, or to credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 3712036-00710 on the account statement.

Claims 1-22 are pending in this application. In the Office Action, Claims 1-3, 5, 9-12, 15-19 and 21-22 are rejected under 35 U.S.C. §102. In response, Applicants have amended Claims 1-3, 5, 9-12, 15-19 and 21-22, have canceled Claims 4, 6-8, 11, 13-14, 16 and 20 without prejudice or disclaimer, and have newly added Claims 23-29. Neither the amendments nor the new claims add new matter. The amendments do not add new matter and are supported in the specification at, for example, page 5, paragraph 12; page 6, paragraphs 16-18. The newly added claims are supported by the originally filed claims. In view of the amendments and/or for the reasons set forth below, Applicants respectfully submit that the rejections should be reconsidered and withdrawn and the application now passed to allowance.

In the Office Action, the Patent Office asserts that the subject matter of the application "admits of illustration by a drawing to facilitate understanding of the invention" and that "applicant is required to furnish a drawing under 37 CFR 1.81(c)." See, Office Action, page 2, lines 3-8. However, Applicants note that drawings were submitted to the Patent Office on February 24, 2006, when the application (along with the originally filed PCT application and English translation) was filed. Indeed, the published application was published with the proper drawings. As such, Applicants submit that the proper drawings have already been submitted to the Patent Office. For at least these reasons, Applicants respectfully request that the request for drawings be reconsidered and withdrawn.

In the Office Action, the Patent Office asserts that Claims 4, 6-8, 13-14 and 20 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. See, Office Action, page 3, lines 20-22. Accordingly, Claims 23-29 have been newly added and include the subject matter of previous Claims 4, 6-8, 13-14 and 20. In this regard, newly added Claim 23 contains the subject matter of originally filed Claims 1 and

4. Newly added Claim 24 contains the subject matter of originally filed Claims 1 and 4-6. Newly added Claim 25 contains the subject matter of originally filed Claim 7. Newly added Claim 26 contains the subject matter of originally filed Claim 8. Newly added Claim 27 contains the subject matter of originally filed Claims 10-13. Newly added Claim 28 contains the subject matter of originally filed Claim 14. Newly added Claim 29 contains the subject matter of originally filed Claim 20. As such, Claims 23-29 do not add new matter and Claims 4, 6-8, 13-14 and 20 have been canceled without prejudice or disclaimer. Accordingly, Applicants respectfully submit that Claims 23-29 are novel, nonobvious and are in position for allowance.

In the Office Action, Claims 1-3, 5, 9 and 21 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,997,103 to Shaw et al. ("*Shaw*"). Applicants respectfully submit that *Shaw* is deficient with respect to the present claims.

Independent Claim 1 recites, in part, a device comprising a housing for receiving a capsule and at least one piercing and injection element having a channel for receiving a liquid under pressure and a distal end arranged in the form of a valve having a closure means with an end, the valve being designed to close off the channel in a first position and to open under the effect of the pressure from the liquid against an elastic element so as to free a passage as a function of the pressure and thus create a layer of liquid sprayed through the passage in a second position. Such a configuration of the piercing and injection element provides the advantage of being self-cleaning since, in the absence of pressure from the liquid being forced through the channel, the passage through which the liquid flows is closed and only opens after the liquid has been pressurized in the channel. Because the passage is closed off by the closure means in the absence of pressure, any problem of obstruction by scale or substance residues is often avoided, even if the capsule has not bee removed from the apparatus immediately after use. See, specification, page 5, paragraph 11. Additionally, by providing a piercing and injection element that includes a distal end arranged as a valve and having a closure means thereon, the configuration allows for easier manufacture and maintenance of the beverage brewing device than devices that require the interaction of many components to perform the same function. Applicants respectfully submit that *Shaw* fails to disclose or suggest each and every element of the present claims.

For example, *Shaw* fails to disclose or suggest the piercing and injection element of independent Claim 1. Specifically, *Shaw* fails to disclose or suggest a piercing and injection element that includes a distal end arranged in the form of a valve having a closure means with an end, the valve being designed to close off the channel in a first position and to open under the effect of the pressure from the liquid against an elastic element so as to free a passage as a function of the pressure and thus create a layer of liquid sprayed through the passage in a second position as required, in part, by independent Claim 1.

Instead, *Shaw* is entirely directed to devices for brewing beverages that include a metal injector tube (7) that projects inward from a clamp member (4), has a circular cross-section and a tip that is obliquely angled in similar fashion to a hypodermic needle. The injector tube (7) further has a recess surrounding the tube. See, *Shaw*, col. 4, lines 48-58. When the injector tube (7) has penetrated a flexible film (1) of the sachet, the injector outlet hole (7) is still covered by flap (8) of the sachet film material. See, *Shaw*, col. 4, lines 65-67. Thus, the flap (8) of the sachet film material may be displaced to allow liquid to flow therethrough. See, *Shaw*, col. 5, lines 4-10. Accordingly, it is clear that the valve effect in *Shaw* is a result of interaction between the liquid injector tube and the sachet film material, and is only present when the injector tube has pierced the sachet and only for as long as the injector is in contact with the sachet. The injector tube of *Shaw* does not have a distal end arranged in the form of a valve.

The configuration of *Shaw* also does not solve the problems discussed in the instant disclosure. In a method of *Shaw*, a valve effect is only provided as long as the injection tube is in contact with the sachet containing the beverage brewing ingredient. This may help to prevent the backflow of the beverage brewing ingredient into the injection tube, but it will not help to prevent the formation of scale that takes place when the injection device is not in contact with the sachet, as water can evaporate from the open end of the injection tube. This is in direct contrast to independent Claim 1, which requires that the piercing and injection element itself have a distal end configured as a valve.

Additionally, the piercing and injection element of *Shaw* is not capable of being configured in a first and second position since the piercing element of *Shaw* is simply a metal injector tube (7) that projects inward from a clamp member (4), has a circular cross-section and a tip that is obliquely angled in similar fashion to a hypodermic needle. This is in direct contrast to

independent Claim 1, which requires the piercing element itself to be capable of configuration in first and second positions.

Further, anticipation is a factual determination that "requires the presence in a single prior art disclosure of each and every element of a claimed invention." *Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 747 (Fed. Cir. 1987) (emphasis added). Federal Circuit decisions have repeatedly emphasized the notion that anticipation cannot be found where less than all elements of a claimed invention are set forth in a reference. See, *e.g.*, *Transclean Corp. v. Bridgewood Services, Inc.*, 290 F.3d 1364, 1370 (Fed. Cir. 2002). As such, a reference must clearly disclose each and every limitation of the claimed invention before anticipation may be found. In the instant case, the Patent Office has failed to identify any disclosure in *Shaw* that demonstrates that the piercing element itself includes a distal end arranged in the form of a valve having a closure means with an end that is capable of arrangement in a first and second position. Instead, the Patent Office must be able to specifically identify the disclosure of each and every limitation of the claimed invention before anticipation may be found.

In the Office Action, Claims 10-12, 15-19 and 22 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,955,116 to Hale ("*Hale*"). Applicants respectfully submit that *Hale* is deficient with respect to the present claims.

Currently amended independent Claim 10 recites, in part, a device comprising at least one piercing and injection element having at least one slot that is transverse to the piercing and injection element, the slot being arranged so as to inject the liquid into the capsule in the form of at least one thin layer extending in a continuous, divergent and multidirectional manner, covering a spray surface in an arc of a circle inside the capsule, wherein the slot extends over an angular sector of between 30 and 180 degrees. Currently amended independent Claim 15 recites, in part, a method of wetting a substance contained in a capsule for producing a beverage having a piercing and injection element, the piercing and injection element arranged so as to inject the liquid into the capsule in the form of at least one thin layer extending in a continuous, divergent and multidirectional manner, covering a spray surface in an arc of a circle inside the capsule, wherein the thin layer covers a spray surface of between 30 and 360 degrees inside the capsule. The amendments do not add new matter and are supported in the specification at, for example, page 5, paragraph 12; page 6, paragraphs 16-18.

Such a spray configuration has the advantage of dispersing the liquid over a large surface while retaining the advantages of power and speed of a jet but avoiding the drawbacks of discrete directed jets that create holes or preferential paths through the substance. The spray also sprays the widest surface possible and allows the injected liquid to flow through the mass, thus ensuring the entire mass is wetted. See, specification, page 6, paragraphs 16-18. Applicants respectfully submit that *Hale* fails to disclose or suggest each and every element of the present claims.

For example, *Hale* fails to disclose or suggest a device comprising at least one piercing and injection element having at least one slot arranged so as to inject the liquid into the capsule in the form of at least one thin layer extending in a continuous, divergent and multidirectional manner, covering a spray surface in an arc of a circle inside the capsule, wherein the slot extends over an angular sector of between 30 and 180 degrees, as required, in part, by independent Claim 10. *Hale* also fails to disclose or suggest a method of wetting a substance using a piercing and injection element arranged so as to inject the liquid into the capsule in the form of at least one thin layer extending in a continuous, divergent and multidirectional manner, covering a spray surface in an arc of a circle inside the capsule, wherein the thin layer covers a spray surface of between 30 and 360 degrees inside the capsule, as required, in part, by independent Claim 15.

Instead, *Hale* is entirely directed to a beverage dispensing apparatus for extracting beverage from a cartridge the includes a slide assembly including a cartridge holder. See, *Hale*, Abstract. Although *Hale* discloses the use of an injector having outlets, the outlets are in the form of angled slots that are cut into the sides of the injector and are angled upward. As such, water flowing through the injector is sprayed upwardly in the cartridge and deflected off the inside surface of the cover and sprayed over the powder contained in the cartridge. See, *Hale*, col. 3, line 65-col. 4, line 11. At no place in the disclosure does *Hale* disclose that the injected spray is in the form of at least one thin layer extending in a continuous, divergent and multidirectional manner, covering a spray surface in an arc of a circle as is required, in part, by the present claims. At no place in the disclosure does *Hale* disclose the specifically recited angles of spray, either. Indeed, the present claims require the use of a spray that sprays in an arc of a circle, which is achieved, in part, by the specific shape of the slots provided in the present claims. The instant spray is also directly contacting the beverage material contained inside the

capsule and does not need to be deflected from any interior cartridge surface, as is the case with the device of *Hale*.

Further, anticipation is a factual determination that "requires the presence in a single prior art disclosure of each and every element of a claimed invention." *Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 747 (Fed. Cir. 1987) (emphasis added). Federal Circuit decisions have repeatedly emphasized the notion that anticipation cannot be found where less than all elements of a claimed invention are set forth in a reference. See, *e.g.*, *Transclean Corp. v. Bridgewood Services, Inc.*, 290 F.3d 1364, 1370 (Fed. Cir. 2002). As such, a reference must clearly disclose each and every limitation of the claimed invention before anticipation may be found. In the instant case, the Patent Office has failed to identify any disclosure in *Hale* that demonstrates that the injected spray is in the form of at least one thin layer extending in a continuous, divergent and multidirectional manner, covering a spray surface in an arc of a circle as is required, in part, by the present claims. The Patent Office has also failed to identify any disclosure wherein *Hale* discloses the specifically recited angles of spray of the present claims. Instead, the Patent Office must be able to specifically identify the disclosure of each and every limitation of the claimed invention before anticipation may be found.

For at least these reasons, Applicants respectfully submit that the anticipation rejections are improper and that *Shaw* and *Hale* fail to anticipate the presently claimed subject matter.

Accordingly, Applicants respectfully request that the rejections of Claims 1-3, 5, 9-12, 15-19 and 21-22 under 35 U.S.C. §102 be reconsidered and withdrawn.

For the foregoing reasons, Applicants respectfully request reconsideration of the above-identified patent application and earnestly solicit an early allowance of same. In the event there remains any impediment to allowance of the claims which could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate such an interview with the undersigned.

Respectfully submitted,

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